

**AMENDMENTS TO THE DRAWINGS**

**Replacement formal drawings of Figures 7 and 8 are submitted concurrently herewith under a separate cover letter.**

## REMARKS

In view of the above amendment and the following remarks, reconsideration of the rejections contained in the Office Action of August 19, 2008 is respectfully requested.

Applicants would like to thank the Examiner for his courtesy in granting and conducting the telephone interview of December 2, 2008. Specific portions of the interview will be referred to in the following discussion.

As an initial matter, it is noted that during the telephone interview, the Examiner indicated that Fig. 8 should be labeled as "Prior Art." In order to address this informal objection, replacement Figs. 7-8 has been submitted under separate cover along with this amendment. It is noted that the replacement Fig. 8 is labeled as "Prior Art." No amendments have been made in replacement Fig. 7, and no new matter has been added by the amendment to Fig. 8. Therefore, entry of replacement Figs. 7-8 is respectfully requested, and it is respectfully submitted that the Examiner's informal objection is not applicable to replacement Figs. 7-8.

On pages 2-3 of the Office Action, the previous Examiner rejected claims 1, 2, 5, 6, 9, 12 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Matsuzaki et al. (JP 2001-270281). For the reasons discussed below, it is respectfully submitted that the present claims are clearly patentable over the prior art of record.

The present invention is directed to a writing implement which has *a center of gravity at a position between a position 20 mm from a writing tip and a position corresponding to the middle of the overall length of the writing implement*. Further, *a weight of a portion of the writing implement between the position 20 mm from the writing tip and the position corresponding to the middle of the overall length of the writing implement is not less than 50% of the total weight of the writing implement*. As discussed on page 4 of the original specification, the positioning of the center of gravity in the manner specified above and the concentration of the weight of the writing implement near the center of gravity produces an improved sensation of balance and stability when using the writing implement.

Further, *the rotational inertia of the writing implement is between 4,300 and 25,000 gf·mm<sup>2</sup> about an axis passing through the center of gravity*. Reducing the rotational inertia of the writing implement in this way increases the ability of the writing implement to be smoothly

operated in minute, reciprocating, turning motions, as discussed on page 9 of the original specification.

In view of the above, independent claim 1 recites a writing implement having a center of gravity at a position between a position 20 mm from a writing tip and a position corresponding to a middle of an overall length of the writing implement. Claim 1 also recites that a weight of a portion of the writing implement between the position 20 mm from the writing tip and the position corresponding to the middle of the overall length of the writing implement is not less than 50% of a total weight of the writing implement. Further, claim 1 recites that a rotational inertia of the writing implement is between 4,300 and 25,000  $\text{gf}\cdot\text{mm}^2$  about an axis passing through the center of gravity.

Matsuzaki discloses a writing implement which, as shown in Fig. 1, includes a main body tube 11 having a front region 16, a rear region 17 and an intermediate region 18 between the front region 16 and the rear region 17. Matsuzaki also discloses that the diameter of the intermediate region 18 is smaller than the diameter of the front region 16 and the diameter of the rear region 17, such that the center of gravity is in the intermediate region 18. However, as noted by the previous Examiner on page 2 of the Office Action, Matsuzaki does not disclose a writing implement in which *a weight of a portion of the writing implement between the position 20 mm from the writing tip and the position corresponding to the middle of the overall length of the writing implement is not less than 50% of the total weight of the writing implement*, as required by independent claim 1.

Nonetheless, the previous Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the writing implement of Matsuzaki such that a portion of the writing implement between the position 20 mm from the writing tip and the position corresponding to the middle of the overall length of the writing implement is not less than 50% of the total weight of the writing implement.

However, it is first noted that on page 2 of the Office Action, the previous Examiner asserts that the limitation in which a weight of a portion of the writing implement between the position 20 mm from the writing tip and the position corresponding to the middle of the overall length of the writing implement is not less than 50% of the total weight of the writing implement

would have been obvious “especially since the Matsuzaki et al. reference also discloses that its center of gravity is substantially in the middle of the implement with the weight obviously not less than 50% of the total weight.”

In this regard, it is noted that Matsuzaki does not disclose a particular weight distribution in the writing implement, and does not disclose or even remotely suggest that the weight of the middle section is “obviously not less than 50% of the total weight,” as asserted by the previous Examiner. Rather, Matsuzaki only discloses that the center of gravity is located in the intermediate section 18 which decreases in diameter towards the center of the intermediate section. Matsuzaki also discloses that the ends of the intermediate section 18 increase in diameter towards the larger front section 16 and rear section 17, respectively. In this regard, it is noted that Matsuzaki does not disclose the weight of the intermediate section 18 compared to the other sections. Further, by disclosing that the outer sections (the front section 16 and the rear section 17) are larger in diameter than the intermediate section 18, Matsuzaki suggests that the majority of the weight is concentrated in the outer ends of the writing implement. Therefore, in view of the above, it is respectfully submitted that Matsuzaki does not disclose or even remotely suggest that the weight of the middle of the implement is “obviously not less than 50% of the total weight,” as stated by the previous Examiner, and that Matsuzaki teaches away from the invention of claim 1 by suggesting that the majority of the weight is concentrated in the outer ends of the writing implement.

Further, as noted by the previous Examiner on page 3 of the Office Action, Matsuzaki does not disclose that *a rotational inertia of the writing implement is between 4,300 and 25,000 gf·mm<sup>2</sup> about an axis passing through the center of gravity*, as required by independent claim 1. However, the previous Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify the writing implement of Matsuzaki such that a rotational inertia of the writing implement is between 4,300 and 25,000 gf·mm<sup>2</sup> about an axis passing through the center of gravity. In support of the conclusion of obviousness, on page 4 of the Office Action, the previous Examiner asserts that the choice of the claimed values for rotational inertia is a mere choice from a “finite number of predictable solutions.”

However, it is noted that Matsuzaka is completely silent as to the rotational inertia of the writing implement. Therefore, the recitation of a rotational inertia of the writing implement being between 4,300 and 25,000  $\text{gf}\cdot\text{mm}^2$  in claim 1 is not a mere choice from a “finite number of predictable solutions” because Matsuzaka does not disclose any values or limitations regarding rotational inertia, and therefore does not disclose or suggest a finite number of values for rotational inertia.

Moreover, it is noted that rotational inertia increases with mass and the distance of the mass from the center of gravity. As indicated above, Matsuzaka suggests that the majority of the weight of the writing implement is concentrated in the outer ends of the writing implement which have the larger diameter compared to the small diameter of the intermediate section. Therefore, because Matsuzaka suggests that the heavier portions of the writing implement are farthest away from the center of gravity, one of ordinary skill in the art would recognize that Matsuzaka suggests a writing implement in which the rotational inertia is maximized. Therefore, it is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to modify the writing implement of Matsuzaka to have a rotational inertia between 4,300 and 25,000  $\text{gf}\cdot\text{mm}^2$  about an axis passing through the center of gravity because Matsuzaka does not disclose the rotational inertia of the writing implement, and because Matsuzaka suggests arranging the heavier portions of the writing implement at the outer ends of the writing implement, which would produce a maximized rotational inertia above the claimed range.

In addition, it is noted that during the telephone interview of December 2, 2008, the Examiner acknowledged the distinctions over the Matsuzaka reference as described above.

Therefore, for the reasons presented above, it is believed apparent that the present invention as recited in independent claim 1 is not disclosed or suggested by the Matsuzaka reference, and that a person having ordinary skill in the art would clearly not have modified the Matsuzaka reference in such a manner as to result in or otherwise render obvious the present invention of independent claim 1.

It is noted that claims 3, 4, 7, 10, 11, 13-16 and 18-20 have been withdrawn from further consideration by the Examiner as being drawn to a non-elected species. In this regard, it is respectfully submitted that independent claim 1 is generic to all of dependent claims 2-7 and 9-

20.

Therefore, it is respectfully submitted that independent claim 1, as well as claims 2-7 and 9-20 which depend therefrom, are clearly allowable over the prior art of record.

In view of the foregoing amendment and remarks, it is respectfully submitted that the present application is clearly in condition for allowance. An early notice to that effect is respectfully solicited.

Respectfully submitted,

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